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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,753	10/29/2003	Wendy D. Stout	WDS/ 001	8784
1473 7590 07/24/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER WONG, STEVEN B	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/697,753

Applicant(s)

STOUT, WENDY D.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.  
4a) Of the above claim(s) 8-12, 19-21, 24 and 38-64 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7, 13-18 and 22-37 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5-27-2004.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Claims 8-12, 19-21, 24 and 38-64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 1, 2007.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell (5,368,301). Mitchell discloses a plurality of universally shaped puzzle pieces (12) which are attached together along a side of the pieces. Note column 4, lines 23-26 stating that the pieces are congruent to one another, only differing in the picture or pattern formed thereon.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (5,368,301). It would have been obvious to one of ordinary skill in the art to provide the puzzle of Mitchell with packaging therefore in order to market the product for sale.

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6. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (5,368,301) in view of Jacoby (6,213,465). Jacoby discloses that it is well known in the art of jigsaw puzzles to provide a blank jigsaw puzzle (3) and a colored jigsaw puzzle (2) and a plurality of customization tools (4) for coloring the blank jigsaw puzzle. It would have been obvious to one of ordinary skill in the art to provide the puzzle of Mitchell with a blank jigsaw puzzle and crayons in order to permit the user to color his own puzzle.

7. Claims 1-7, 13, 16-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301). Regarding claim 1, Krisch discloses a puzzle comprising a puzzle piece having first and second surfaces. Note the Abstract of the Disclosure stating that at least one side of the puzzle pieces is left blank so that a user may print an image thereon. It would have been obvious to one of ordinary skill in the art to provide a blank surface on both sides of the pieces in order to allow the user to print an image on both sides.

It would have been obvious to one of ordinary skill in the art to form the pieces of Krisch with a universal shape as taught by Mitchell in order to simplify the puzzle and have the user solve the puzzle simply based on the image printed thereon.

Regarding claims 2 and 3, Krisch teaches printing on the surfaces of the pieces. The pieces are obviously capable of being customized.

Regarding claims 4 and 6, Krisch states that at least one of the sides of the puzzle is blank. By providing only a single side as a blank, the other surface of the puzzle is non-customizable.

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Regarding claims 5 and 7, it would have been obvious to one of ordinary skill in the art to provide a logo on the surface of the puzzle in order to advertise a particular manufacturer.

Regarding claims 13 and 16-18, the puzzle pieces of Mitchell are symmetrical and have three sides. Further, the pieces provide a male connector having indicia thereon.

Regarding claim 22, Krisch states that the puzzle of his invention is made from cardboard.

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Hassenbach (2,953,380). Hassenbach merely discloses that it is well known in the art puzzles to provide a universal puzzle piece having a square shape. It would have been obvious to one of ordinary skill in the art to form the puzzle pieces of Krisch as modified by Mitchell in a square shape in order to provide an alternative shape for the user to solve the puzzle with.

9. Claims 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Gallant (6,517,071). Gallant discloses that it is well known in the art of jigsaw puzzles to form the puzzle from a first material (5) with a second material (9) bonded thereto. It would have been obvious to one of ordinary skill in the art to form the puzzle pieces of Krisch from the material as taught by Gallant in order to provide a more flexible sheet material for the puzzle.

Regarding claim 25, note the rejection of claim 4 above.

Regarding claim 26, Gallant teaches bonding the first and second layers together.

10. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Ozrovitz (5,213,507). Regarding claim 27,

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Ozrovitz discloses that it is well known in the art of jigsaw puzzles to incorporate the puzzle (28) into a book (10). The book provides a plurality of layers of material (18). It would have been obvious to one of ordinary skill in the art to provide the puzzle of Krisch in a book as taught by Ozrovitz in order to provide a story with the puzzle for the user.

Regarding claim 28, the pages are bound to the first layer and removable therefrom.

Regarding claim 29, the plurality of pages are made from paper.

Regarding claim 30, Krisch teaches for his puzzle to be formed from cardboard.

11. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Ruben (5,746,429). Ruben discloses that it is well known in the art of toys and puzzles to provide an envelope (12, 14, 16, 18) for storing the pieces (2) when not in use. It would have been obvious to one of ordinary skill in the art to provide the puzzle of Krisch with an envelope in order to store the puzzle when not in use.

Regarding claim 32, it would have been obvious to one of ordinary skill in the art to form the envelope from a transparent material in order to allow the user to view the contents of the envelope.

Regarding claim 33, Krisch teaches using a printer for printing on the puzzle. The printer is a customization tool.

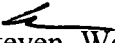
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
July 17, 2007